



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/825,604

04/03/2001

Anthony Aquila

3275

30764

7590

03/19/2007

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
333 SOUTH HOPE STREET
48TH FLOOR
LOS ANGELES, CA 90071-1448

EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT

PAPER NUMBER

3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

03/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/825,604

Applicant(s)

AQUILA ET AL.

Examiner

Luke Gilligan

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-25, 36-82 and 84-93 is/are pending in the application.
- 4a) Of the above claim(s) 15-24 and 36-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25, 73-82, and 84-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/27/06 has been entered.

Response to Amendment

2. the amendment filed 9/11/06, the following has occurred: claims 25, 73-74, 76, 78, 80, and 84 have been amended, claims 85-93 have been added, and claim 83 has been canceled. Now, claims 25, 73-82, and 84-93 are presented for examination, while claims 15-24 and 36-72 are withdrawn.

Claim Rejections - 35 USC § 102

3 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 25, 73-81, and 84-92 are rejected under 35 U.S.C. 102(e) as being anticipated by Borghesi et al., U.S. Patent No. 5,950,169.

5. As per claim 25, Borghesi teaches a computer implemented method of determining a type of assignee to whom to assign an insurance claim, the method comprising: receiving data

Art Unit: 3626

related to the insurance claim, the data comprising a plurality of data elements, a data element serving as an assignment criterion (see column 9, lines 22-29); determining a score of a data element, the score responsive to scoring rules (see column 13, lines 18-20; the Examiner interprets the "threshold total valuation number" to be a type of score as recited); determining a score of the insurance claim responsive to a score of at least one data element (see column 13, lines 18-20); determining a priority of the insurance claim according to the score of the insurance claim (see column 13, lines 14-18; the Examiner interprets the determination that total cost is approaching the threshold to be a type of determining a priority as recited); determining a class of the insurance claim according to classing rules (see column 12, lines 14-19 and column 13, lines 12-15; the Examiner interprets the type of vehicle to be a type of the recited class since it is used to determine values for the claim); and determining a type of assignee to whom to assign the insurance claim according to the application of business rules to the score of the insurance claim and the class of the insurance claim, wherein the business rules weight the class more highly than the score (see column 13, lines 49-53, the Examiner is interpreting the transfer of the claim to the third party service provider to be a form of assigning the claim to the third party service provider).

6. Claims 73-74, 76-77, 79, and 81 contain substantially similar limitations to those already addressed in claim 25 and, as such, are rejected for similar reasons as given above.

7. As per claim 75, Borghesi teaches the method of claim 73 as described above.

Borghesi further teaches the claim score reflects a severity of the insurance claim (see column 8 lines 12-23, since the "score" of Borghesi reflects the potential cost of repair of the vehicle, it is submitted that such an indication is a reflection of the "severity" of the insurance claim as well).

8. As per claim 78, Borghesi teaches the method of claim 73 as described above.

Borghesi further teaches an assignee comprises one element of a group containing an

Art Unit: 3626

insurance adjuster, a repair facility, an appraiser, and a rental provider (see column 9, lines 24-29).

9 As per claim 80, Borghesi teaches the method of claim 79 as described above.

Borghesi further teaches the effect of one data element on the claim score is greater than an effect of another data element on the claim score (see column 13, lines 18-20, the Examiner is interpreting the cost data element to have a greater effect in the context of Borghesi).

10. As per claim 81, Borghesi teaches the method of claim 79 as described above.

Borghesi further teaches each data element includes an element score, and wherein the claim score is based on the element scores of the data elements (see column 13, lines 18-20).

11. Claims 84-92 contain substantially similar computer program product limitations to method claims 73-81 and, as such, are rejected for similar reasons as given above.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 82 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al., U.S. Patent No. 5,950,169 in view of Brookes et al., U.S. Patent No. 6,950,801.

14. As per claim 82, Borghesi teaches the method of claim 73 as described above.

Although Borghesi teaches profiles for potential assignees of the determined type (see column 9, lines 18-33), Borghesi does not explicitly teach determining a set of profiles with highest profile scores that include a measure of capacity to complete the insurance claim and determining the profile with the largest measure of capacity. Brookes teaches a method for

assigning insurance claims to repair facilities that includes the steps of: determining a first set of profiles, wherein each profile in the first set represents a potential assignee and wherein each profile in the first set includes a profile score (see column 9, lines 2-10); determining a second set of profiles, wherein the second set contains profiles in the first set that have the highest profile scores, and wherein each profile in the second set includes a measure of capacity to complete the insurance claim (see column 11, lines 6-13); and determining from the second set of profiles, a profile with the largest measure of capacity (see column 11, lines 13-19 and lines 39-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a method of determining a best profile of a potential assignee into the system of Borghesi. One of ordinary skill in the art would have been motivated to incorporate such a method of the purpose of providing a more advantageous method of coordinating repair for policyholders of insurance companies by eliminating the need for repair middlemen (see column 2, lines 50-56 of Brookes).

15. Claim 93 recites substantially similar additional limitations to those already addressed in claim 82 and, as such, is rejected for similar reasons as given above.

Response to Arguments

16. In the remarks filed 9/11/06, Applicants argue in substance that (1) Borghesi does not teach choosing a valuation service based on cost and vehicle type nor weighting of either factor; (2) Borghesi fails to teach that the score is determined based on information regarding an insurance policy, a party involved in a loss, or how a loss was reported; (3) Brookes does not teach a measure of capacity for the repair shops; and (4) Borghesi teaches away from incorporating the teachings of Brookes.

Art Unit: 3626

17. In response to Applicant's first argument, the Examiner respectfully submits that, as described in the previous Office Action, the user is notified that the total repair cost for the particular vehicle type is approaching a threshold value. Then, if a custom valuation is needed, it is determined that the claim should be assigned to a third party provider (i.e. a type of assignee). Clearly, this assignment is based on repair cost and vehicle type. Therefore, the Examiner respectfully maintains that Borghesi teaches this feature as recited in the claims. Furthermore, since vehicle type is required to determine repair cost, it is respectfully submitted that this element has a higher weight.

18. In response to Applicant's argument (2), the Examiner respectfully submits that the type of vehicle involved in the loss is a type of "information regarding a party involved in a loss" as recited in the claim. Since repair cost can only be calculated by knowing the vehicle type, it is maintained that Borghesi teaches the "score" is based on this type of information.

19. In response to Applicant's argument (3), the Examiner respectfully submits that the satisfaction index, as utilized in the system of Brookes, is a measure of capacity to complete vehicle repairs associated with insurance claims. It should be noted that the satisfaction index is based on past performance of repair shops. It is respectfully submitted that the performance of a repair shop is a measure of that repair shop's capacity to perform repairs. Therefore, the Examiner respectfully maintains that Brookes teaches this feature as recited in the claims.

20. In response to Applicant's argument (4), it is respectfully submitted that Applicants have not shown any teachings in Borghesi that specifically would have discouraged one of ordinary skill in the art not to look to the teachings of Brookes for profiling and ranking service providers. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d

Art Unit: 3626

551, 553 (Fed. Cir. 1994). In this case, there do not appear to be any teachings in Borghesi that specifically teach away from the profiling taught in Brookes.


Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

3/16/07


C. LUKE GILLIGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600